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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,289	07/14/2003	Yanbin Liang	17561 (AP)	3328
51957	7590	02/01/2006	EXAMINER	
ALLERGAN, INC., LEGAL DEPARTMENT 2525 DUPONT DRIVE, T2-7H IRVINE, CA 92612-1599			ULM, JOHN D	
			ART UNIT	PAPER NUMBER
			1649	
DATE MAILED: 02/01/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/620,289	<b>Applicant(s)</b> LIANG ET AL.	
	<b>Examiner</b> John D. Ulm	<b>Art Unit</b> 1649	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 11,12,20,21,33,34,46 and 47 is/are objected to.
- 8) ☒ Claim(s) 1-10 13-19 22-32 35-45 48-58 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

Art Unit: 1649

1) Claims 1 to 58 are pending in the instant application.

2) Claims 11, 12, 20, 21, 33, 34, 46 and 47 are objected to under 37

CFR 1.75(c) as being in improper form because a multiple dependent claim must depend from other claims in the alternative only. See MPEP § 608.01(n). Accordingly, these claims have not been further treated on the merits.

3) Restriction to one of the following inventions is required under 35 U.S.C.

121:

I. Claims 2 and 7, only in so far as they relate to an isolated polypeptide comprising SEQ ID NO:14, classified in class 530, subclass 350.

II to X. Claims 1, 2 and 7, only in so far as they relate to an isolated polypeptide comprising one of the nine different amino acid sequences recited in claim 1, classified in class 530, subclass 350.

XI to XVI. Claims 3, 4 and 7, only in so far as they relate to an isolated polypeptide comprising one of the six different amino acid sequences recited therein, classified in class 530, subclass 325.

XVII to XXI. Claims 5 and 6, only in so far as they relate to an antibody that binds to a polypeptide having one of the five different amino acid sequences recited, classified in class 530, subclass 388.22.

XXII. Claims 8 to 10, 13 to 19, 22 to 32, 35 to 45 and 48 to 53, drawn to a receptor binding assay, classified in class 435, subclass 7.21.

Art Unit: 1649

XXIII to XXVII. Claim 54, only in so far as it relates to an isolated nucleic acid encoding a polypeptide comprising one of the five different amino acid sequences recited classified in class 536, subclass 23.5.

XXVIII to XXXIII. Claims 55 to 58, only in so far as they relate to an isolated nucleic acid molecule encoding a peptide comprising one of the six different amino acid sequences recited, classified in class 536, subclass 23.5.

The inventions are distinct, each from the other because of the following reasons:

The compounds that define inventions I to XXI and XXIII to XXXIII are thirty two different chemical compounds that do not reflect a common invention concept because they lack a common structural feature or combination of features that distinguishes them as a group from the prior art. For example, the text in lines 17 and 18 on page 4 of the instant specification discloses that the amino acid sequences presented in SEQ ID NOs:14 and 17 to 25 are natural variants of a known receptor whose amino acid sequence is presented in SEQ ID NO:13. Further, a comparison of the amino acid sequence of SEQ ID NO:2 to SEQ ID NO:13 reveals no structural relationship of any kind between these compounds. These thirty-two different compounds are patentably distinct because each one can be made and used without the others and because they can not be distinguished as a group from the prior art.

Inventions I to X are each related to invention XXII as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another

Art Unit: 1649

materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case each of the claimed products can be used as an immunogen in a process of inducing the production of antibodies thereto, which is materially different from the assay of invention XXII because it employs different steps to achieve a different objective.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4) Claims 8 to 10, 13 to 19, 22 to 32, 35 to 45 and 48 to 53 are generic to a plurality of disclosed patentably distinct species of receptor.protein as listed in claim 2. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Art Unit: 1649

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (571) 272-0880. The examiner can normally be reached on 9:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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